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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,301	06/24/2003	Norman Ken Ouchi		3141
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NORMAN KEN OUCHI P.O. BOX 20111 SAN JOSE, CA 95160				
EXAMINER				
ALMATRAHI, FARIS S				
ART UNIT		PAPER NUMBER		
3627				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/602,301

Applicant(s)

OUCHI, NORMAN KEN

Examiner

FARIS ALMATRAHI

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-17 and 21-31 is/are pending in the application.
- 4a) Of the above claim(s) 12-17 and 21-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-11, and 25-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Application

1. This action is in reply to applicant Request for Continued Examination filed January 30, 2009.
2. Claims 1-8 and 10-11 have been amended.
3. Claims 9 and 18-20 have been cancelled.
4. Claims 12-17 and 21-24 are withdrawn due to non-elected restriction requirement.
5. Claims 25-31 are new.
6. Claims 1-8, 10-17 and 21-31 are pending.

Drawings

7. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the methods recited in claims 1-8, 10-11 and 25-31 such as steps of adding a character or substring of characters, appending labels, ordering parameters and encoding value for each parameter, generating compact item descriptors, comparing compact item descriptors, a database, generating a commodity code, querying item description field, providing database entry, providing a part number, providing an item description field, providing supplier name, and providing supplier part number must be shown on the feature(s)

canceled from the claim(s). No new matter should be entered. Applicant is requested to review amended claims to ensure every feature is included in the drawings.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8, 10-11 and 25-31 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In *re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101.

Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. **Claims 1-8, 10-11 and 25-31** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. **Claim 1** recites the limitation "adding at each fork of the classification tree a character or sub-string of characters as a label that distinguishes each child branch or leaf of the fork; generating a commodity code, a character string that uniquely identifies the sequence of branches and leaf selected for the classification of an item represented by the leaf". There is insufficient antecedent basis for the phrase "each fork" and "each child branch" in the claim. The limitation is also viewed to be vague and indefinite because it is not clear if the features of "each child branch or leaf of the fork" are distinct from the feature "sequence of branches and leaf". There is also insufficient antecedent basis in the claim for the phrase "ordering the set of parameters for each leaf", "generating the compact item descriptor for an item", "generating the compact item descriptor for the first item", and "generating the compact item descriptor for the second item". Claim 1 also recites "comparing the compact item descriptor for the first item with the compact item descriptor for the second item where the two compact descriptors are the same and the items are interchangeable or the compact item descriptors are different and the items are not interchangeable". The limitation as phrased is viewed to be vague and indefinite because it is unclear what the applicant is referring to. It is

unclear if the applicant is comparing the compact item descriptor for the first item with the compact item descriptor for the second item to determine if the two compact descriptors are the same or if the compact item descriptors are different. The limitation as claimed appears to imply that applicant is comparing the compact item descriptor for the first item with the compact item descriptor for the second item where the two compact descriptors are the same and the items are interchangeable (comparison occurs where descriptors are the same making it vague as to why a comparison is needed if they are the same). Applicant is requested to construct claims eliminating ambiguity and clarifying what he is referring to. **Similar comments of issues identified for claim 1 also apply to Claims 25 and 29.**

12. Applicant is requested to review claims 1-8, 10-11, and 25-31 for lack of antecedent basis. Claims contain excessive lack of antecedent basis. For example, in addition to antecedent basis issues identified above, claim 3 recites "the compact item descriptor of claim 1, database, and interchangeable first item". There is no antecedent basis for the "database" recited in claim 3 in reference to claim 1.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 10-11, and 25-31, as best understood, are rejected under 35 U.S.C 103(a) as being unpatentable over Blutinger et al. (US Patent No. 5,231,566) in view of Kavanagh et al. (US Patent No. 5,838,965).

Blutinger et al., as applied above shows all of the limitations of the claims except for appending a character or substring of characters as a label that distinguishes each child branch or leaf; defining a set of parameters of each leaf that complete the description of an item classified at the leaf and encode the possible value for each parameter as a character or string of characters; and querying a database with an input field of an item to generate requested criteria of the item and querying a supplier suffix table.

Blutinger reads on a method comprising defining a classification tree which classifies a set of items (Abstract, Figure 2, Column 3 lines 19-37; generating a commodity code for each branch and leaf of the classification tree (Column 3 lines 19-37); and defining an item descriptor for an item as the commodity code (Column 3 lines 19-37, Column 9 line 63 – Column 10 line 15); comparing item descriptors of a first item with that of a second item (Abstract, Column 11 lines 28- 63); and a storage database providing an entry including an item part number and item description (Column 5 lines 52-61, Column 7 lines 28-45).

Kavanagh teaches a method comprising appending a character or substring of characters as a label that distinguishes each child branch or leaf (Column 70 lines 31-54); defining a set of parameters of each leaf that complete the description of an item classified at the leaf and encode the possible value for each parameter as a character

or string of characters (Column 54 line 63 – Column 55 line 40); and querying a database wherein the database is queried with an input field of an item to generate requested criteria of the item including a supplier suffix data (Column 77 lines 21-28, Column 79 lines 22-30).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Kavanagh in the device of Blutinger reference to include a method comprising appending a character or substring of characters as a label that distinguishes each child branch or leaf; defining a set of parameters of each leaf that complete the description of an item classified at the leaf and encode the possible value for each parameter as a character or string of characters; and querying a database with an input field of an item to generate requested criteria of the item and querying a supplier suffix table, for the advantage of allowing a user to look up and identify relevant product information.

Response to Arguments

14. Applicant's arguments filed on November 10, 2008 have been fully considered but they are not persuasive.

15. Regarding Applicants arguments with respect to the Drawing objections. Applicant is reminded that the tables referenced in the arguments to overcome objection are tables that are part of the specifications and not included in the Drawings. Only figures that are part of the drawing can be referenced to overcome the Drawing

objection. Furthermore, it is noted that the figures in the Drawings do not clearly illustrate the objected features of the method flow claimed in the current invention.

16. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faris Almatrahi whose telephone number is (571) 270-3326. The examiner can normally be reached on Monday to Friday 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Faris Almatrahi/
Examiner, Art Unit 3627

FA

/F. Ryan Zeender/
Supervisory Patent Examiner, Art Unit 3627